

Appl. No. 10/695,707  
 Amdt. dated July 11, 2006  
 Reply to office action of April 26, 2006

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### REMARKS

Applicant has received the office action dated April 26, 2006, in which the examiner rejected claims 1-33 under 35 U.S.C. § 101 as being non-statutory subject matter. With this response, applicant amends claims 1, 18, and 29-31. In view of these amendments and the following remarks, applicant respectfully requests reconsideration.

#### I. REJECTIONS UNDER 35 U.S.C. § 101

Claims 1-33 stand rejected under 35 U.S.C. § 101. In response, applicant has amended the independent claims to more clearly recite statutory subject matter.

Independent claim 1 recites "presenting to a user a list of choices ordered in accordance with the overall scores." (Support for this amendment can be found in ¶¶1 of the specification.) In addition to being perceptible to a user, this list is expected to be of great practical value. Thus this limitation provides a result that is at least as "useful, concrete and tangible" as the share prices that were calculated in the State Street case (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998)). In that case, the court noted "transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601. Because an object's price is widely regarded as intangible, the courts are clearly not interpreting the term "tangible" in a strict sense, but rather as a general descriptor of the subject matter's utility. For at least this reason, independent claim 1 and its dependent claims 2-17 are patentable.

Independent claim 18 has been amended to recite a system having a specific practical application, namely, to classify visitors to a website. (Support for this amendment can be found in ¶¶10 of the specification.) As noted in the MPEP

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§ 2106 IV.B.2(a) (p. 2100-15 in 8<sup>th</sup> ed. rev 3), "A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory. In most cases, a claim to a specific machine or manufacture will have a practical application in the technological arts." Since claim 18 is directed to a specific machine, it certainly falls within this category, even before the amendment. For at least this reason, independent claim 18 and its dependent claims 18-28 are patentable.

Independent claim 29 has also been amended to recite a system having a specific practical application, namely, to rank a company's products. (Support for this amendment can be found in ¶9 of the specification.) Because it is drafted in means plus function format, claim 29 is directed to the specific structures (and equivalents thereof) disclosed in the specification, and hence, it is also directed to a specific machine that falls within the realm of statutory subject matter. For at least this reason, independent claim 29 and its dependent claim 30 are patentable.

Independent claim 31 recites "software configures the computing device to ... display a list of choices ordered in accordance with overall scores." As argued above with respect to independent claim 1, this list satisfies the requirements for statutory subject matter. For at least this reason, independent claim 31 and its dependent claims 32-33 are patentable.

## II. CONCLUSION

In the course of the foregoing discussions, applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

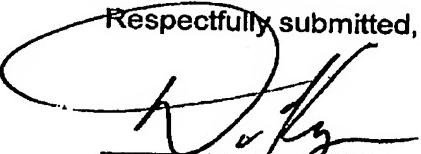
Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or

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fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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